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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/540,124 | 06/02/2006 | Bernard Phillippe Albert Boitrel | 0508-1137 | 1073 |

466 7590 09/15/2010
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209 Madison Street
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| EXAMINER |
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PACKARD, BENJAMIN J

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| ART UNIT | PAPER NUMBER |
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1612

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| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

09/15/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/540,124 | Applicant(s) BOITREL, BERNARD PHILLIPPE ALBERT | |
| | Examiner Benjamin Packard | Art Unit 1612 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-38 is/are pending in the application.
- 4a) Of the above claim(s) 23-28 and 31-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-22, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' arguments, filed 3/3/10, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 20-22 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Didier et al (Eur J Organic Chem (2001) 1917-1926, IDS dated 09/20/05) in view of Wheelhouse et al (US 6,087,493).

Applicants assert Wheelhouse is directed to compounds with electron-withdrawing groups at the meso position, whereas the instant compounds bears aniline or anilide groups. Applicants also assert the structure and role of the porphyrins described in Wheelhouse are completely different from the presently claimed porphyrin, where the skilled artisan would not have completed the metal complex disclosed in Didier to optimize the efficacy of the porphyrin. Applicants also assert Boitrel et al was partially relied upon for disclosing a CO group which belongs to an amide groups which in turn belongs to the same chain as the CO group, whereas the present invention claims a CO group belonging to an ester or an acid group which have been added and therefore is hanged, but not included to the strap. Applicants also assert the compounds

of formula I present two points of functionalization, the -COOH group for stabilizing the metal and the -CH₂NH₂ group for the attachment of an antibody.

Examiner disagrees. First, Wheelhouse was not cited for the core structure, but for the teaching that nitrophenyl groups are known stabilizing ligands in porphyrin compounds, and that stabilizing ligands are known to have an electron withdrawing group. Therefore, the difference in location of the actually position in Wheelhouse is not relevant where the core structure is taught by the primary reference.

Second, while the core structures of the two porphyrin compounds disclosed in the prior art reference may differ slightly, they share a common metal complex, which reasonably is expected to require stabilization. In fact, the secondary reference specifically discusses the ability of ligands to stabilize the metal. As such, the skilled artisan would recognize that the compound of the primary reference may further be stabilized by the substitution of another stabilizing ligand for the ligands of the primary reference.

Third, again, the figures at scheme 3 of Didier et al suggest the compound is the same as instantly elected, except for one ligand at the instantly claimed "U" site. Therefore, it is unclear how the compounds differ as asserted by Applicant.

Fourth, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., two points of functionalization) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). Here, the claims are directed to a compound, and as such, the compound may be used for purposes other than intended by Applicant. Thus, the ability to use the ligands as Applicant intends is not given consideration with respect to the instant claims.

Conclusion

No claims allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Packard whose telephone number is 571-270-3440. The examiner can normally be reached on M-R 8-6 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin Packard/
Examiner, Art Unit 1612

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612